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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/903,743	07/31/1997	TIMOTHY MERRICK LONG	169.0568	2593
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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 09/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/903,743

Applicant(s)

LONG ET AL.

Examiner

CESAR B. PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the RCE filed on 7/19/2005.

This action is made Non-Final.

2. In the amendment, claims 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-57 are pending in the case. Claims 1, 27-29, 31, 38, and 54-57 are independent claims.

Drawings

3. The drawings filed on 5/11/2004 have been accepted by the Examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-4, 7, 9-12, 27-29, 31, 38, 42-57 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on 10/4/96), in view of Savitzky et al, hereinafter Savitzky (Pat. # 6,012,083, 1/4/2000, filed on 9/24/1996).

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Regarding independent claim 1, Nehab teaches the creation of a personalized document. This document is created by collating and arranging various stand alone web pages of different newspapers articles into a single linear or continuous printable document. A “site driver” is used for monitoring web page sections accessed, and url addresses or commands—*access patterns* of websites accessed by the user-- entered by a user into a profile editor-- *second application operating on a local machine--* while navigating a network web pages—*accessing plurality of hyper-text documents and formatting information*. The driver records the web sites accessed in a log, as urls or as rules, for the later retrieval, and formatting these documents into a single linear document of documents similar to those accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67, fig.1,4). Nehab fails to explicitly disclose: *monitoring a second application operating independently of operations of said first application on said local machine, wherein the monitoring identifies the plurality of hyper-text documents accessed independently by the second application*. However, Savitzky teaches an independent agent for providing a history of all the documents accessed by client(s), which can be located anywhere on a network where the agent is reachable by multiple browsers(col.3, lines 45-67, col.12, lines 16-32, col.10, lines 51-56, abst., fig.1). In other words, if the user has Netscape, and Internet Explorer browsers on his computer, the agent would be located on the computer, separate or operating independently from the browsers, so as to be very accessible by the browsers. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Nehab, and Savitzky, and have monitored the second application--client, because Savitzky teaches providing agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This provides

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the benefit of providing an agent that is flexible, and does not depend or is tied down to either the client or server, and that can be quickly accessed by the browsers locally.

Moreover, Nehab teaches the recording of selected hyperlinks portions or articles of webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67, c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages using the address/location—*formatting information*, and/or articles of different newspapers into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67, c.9,L.40-63).

Regarding claim 3, which depends on claim 1, Nehab teaches the creation, by a stand alone *first application*, of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.9,L.40-62). Nehab fails to explicitly disclose:*the printable document is updated upon new hyper-text pages being accessed by the second application*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have updated the document, because Nehab teaches the duplication of user's selection criteria in clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and interactively reproducing user's selection of hyperlinks, while avoiding time consuming manual update of the document.

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Regarding claim 4, which depends on claim 1, Nehab teaches a tracking program for the monitoring of url addresses or commands entered by a user while navigating a network web pages (c. 8,L.34-67)-- *....said steps are performed in a background mode relative to the user's access to the hyper-text documents.*

Regarding claim 7, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document of multiple columns (c.14, L.47, and c.16,L.1-67).

Regarding claim 9, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document with an index, and table of contents of the links to articles source links in the web pages (c.14, L.47-67, and c.15,L.20-c.16,L.67)--*....the printable document comprises a table of contents listing each hyper-text document*

Regarding claim 10, which depends on claim 1, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink references to the articles' sources --*....hyper-link index of at least one hyper link reference ...* (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 11, which depends on claim 10, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink cross-references to an index -

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-.... each hyper-link reference in the printable document is tagged with a cross reference to a corresponding entry ... (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 12, which depends on claim 10, Nehab discloses including all hyperlink references of each article represented in the formatted document *said hyper-link index comprises all hyper-link references of each hyper-text--(c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).*

Claim 22 is directed towards a method for carrying out the steps found in claim 12, and therefore is similarly rejected.

Regarding independent claim 27, Nehab teaches the creation, by a stand alone *first application in a local computer*, of a personalized document by collating and arranging various web pages, from websites--*sources*, of different newspapers articles into a single linear or continuous printable document according to the size of the respective articles (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 1, 4, 9A). Nehab fails to explicitly disclose: *monitoring accesses by the second application to the plurality of documents in sequence, the access occurring independently of operation of said first application, with the monitoring identifying the plurality of documents.* However, Savitzky teaches an independent agent for providing a history of all the documents accessed by a client(s), which can be located anywhere on a network where the agent is reachable by multiple browsers(col.3, lines 45-67, col.12, lines 16-32abst., fig.1). In other words, if the user has Netscape, and Internet Explorer browsers on his computer, the agent would be

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located on the computer, separate or operating independently from the browsers, so as to be very accessible by the browsers. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have monitored the second application--browser, because Nehab teaches the duplication of user's selection criteria in clicking on hyperlinks in a web site (col. 8, lines 34-67), and Savitzky teaches providing agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This provides the benefit of automatically, and interactively monitoring user's selection of hyperlinks, while interacting with only one application—the browser—instead of manually interacting with both the browser and the web reader to input user's browsing preferences. This also provides the benefit of providing an agent that is flexible, and does not depend or is tied down to either the client or server, and that can be quickly accessed by the browsers locally.

Moreover, Nehab teaches the recording of selected hyperlinks of portions or articles of webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67, c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages according the address/location—*formatting information*, and/or articles of different newspapers—*size information--* into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67, c.9,L.40-63).

Claim 28 is directed towards a computer system for carrying out the steps found in claim 27, and is similarly rejected.

Claim 29 is directed towards a computer readable medium for storing the steps found in claim 1, except for the retrieval of documents from a network, which is taught by Nehab (col.8, lines 33-67, fig.4), and is similarly rejected.

Claim 31 is directed towards a computer program product having a computer readable medium, and a browser for storing, and implementing the steps found in claim 1, and is similarly rejected.

Claim 38 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 27, except for the access patterns (which is taught by Nehab as indicated in the rejection of claim 1) and is similarly rejected.

Claims 42-45 are directed towards a method for forming a single printable documents for carrying out the steps found in claim 1, and therefore are similarly rejected

Claims 46-47 are directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and therefore are similarly rejected.

Regarding independent claim 48, Nehab teaches the creation, by a stand alone *first application in a local computer*, of a personalized document. This document is created by collating and arranging various stand alone web pages of different newspapers articles into a single linear or continuous printable document. A “site driver” is used for monitoring web page sections accessed, and url addresses or commands—*access patterns* of websites accessed by the

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user-- entered by a user into a profile editor-- *second application*-- while navigating a network web pages—*accessing plurality of hyper-text documents and formatting information*. The driver records the web site accessed in a log, as urls or as rules, for the later retrieval, and formatting into a single linear document of documents similar to those accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67, c.9,L.62-c.10,L.21, fig.1,4). Nehab fails to explicitly disclose: *displaying the list of the plurality of documents*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have displayed the list of documents, because this would have enabled the user to edit the list of documents according to user's preferences, and taste, as suggested above.

Moreover, Nehab fails to explicitly disclose: *access occurring independently, and fetching independently of the second application each document selected from the list and formatting*. However, Savitzky teaches an independent agent for providing a history of all the documents accessed by a client(s), which can be located anywhere on a network where the agent is reachable by multiple browsers(col.3, lines 45-67, col.12, lines 16-32abst., fig.1). In other words, if the user has Netscape, and Internet Explorer browsers on his computer, the agent would be located on the computer, separate or operating independently from the browsers, so as to be very accessible by the browsers. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Nehab, and Savitzky, and have monitored the second application--client, because Savitzky teaches providing agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This provides the benefit of providing an agent that is flexible, and does not depend or is tied down to either the client or server, and that can be quickly accessed by the browsers locally.

Furthermore, Nehab teaches the a graphical user interface for editing the document list or profile, and formatting of the various web pages according to user's dictates (c.9, L.35-67).

Claim 49 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 48, and is similarly rejected.

Regarding claim 50, which depends on claim 48, Nehab teaches the creation of a personalized document by retrieving, collating—*compiling*-- and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.10,L.21-44).

Claims 51-53 are directed towards a computer program product having a computer readable medium for storing the steps found in claims 48-50, and therefore are similarly rejected.

Claim 54 is directed towards a method for forming the print list for found in claim 1, Savitzky teaches the compilation of a hotlist by an agent independently from the browser—without waiting for an instruction from the browser to perform the compilation (col.3, lines 45-67, col.12, lines 16-32abst., fig.1)--and is similarly rejected.

Claim 55 is directed towards an apparatus for carrying out the steps found in claim 1, and is similarly rejected.

Claim 56 is directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and is similarly rejected.

Claim 57 is directed towards a computer apparatus for carrying out the program found in claim 48, and is similarly rejected.

6. Claims 32-33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab, in view of Savitzky, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94).

Regarding claim 32, which depends on claim 7, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose: *....maximizing the number of hyper-text documents on each page.....* However, Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, Savitzky, and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

Regarding claim 33, which depends on claim 32, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose: *....determining if space exists on a page of the printable document.....if so, inserting the formatted hyper-text document.....* However, Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, Savitzky, and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

Response to Arguments

7. Applicant's arguments filed 7/19/2005 have been fully considered but they are not persuasive. Applicants indicates that “The basis of the outstanding rejection requires that the agency program of Savitsky et al. be incorporated into the system of Nehab. et al. in order to achieve the ‘monitoring’ of the present invention. However, in any practical implementation of the agency program of Savitsky. et al., the program conveys the ‘www’ request commands and replies to and from the browser. It logically follows that the browser (e.g., second application) does not operate independently of the agency propam with such conveyances. More specifically, in order to perform the monitoring, the browser would need to conduct operations dependent upon commands being conveyed through the agency program and data being returned from the web via the agency program” (page 21, parag.3). The Examiner disagrees, because Savitzky

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teaches that the agent monitors, and compiles a list of the sites accessed by a user (col.3, lines 45-67, col.12, lines 16-32). Instead of the browser creating, and accessing the list, the agent produces the list, which the user can then access independent from the browser.

Moreover, the Applicants indicate that “The agency program of Savitsky. et al. fails to meet these criteria. In particular, the system of Savitsky. et al. operates by interpreting the browser commands and then passing those browser commands from the client to the server, as well as operating in a similar fashion with the return data. Thus, even when combined with

Nehab. et al. independent operation would not be achieved. In addition to the combination proposed in the Office Action not providing the patentable aspects of the present invention, Applicants also submit that the proposed combination is not proper. In order to achieve the proposed combination, the system in Nehab. et al. would be forced to communicate with the agency program of Savitsky et al.. The Examiner has not identified any motivation to cause Nehab. et al. to work in this manner. In particular, Nehab. et al. is, on its own, able to access the web and create its own record of locations under user control, without any need for an intervening agency program. Thus, there would be no need to provide such an agency program to the system described in Nehab. et al.” (page 22). The Examiner disagrees, because Savitzky teaches that the agent monitors, and compiles a list of the sites accessed by a user (col.3, lines 45-67, col.12, lines 16-32, col.10, lines 51-56). Instead of the browser creating, and accessing the list, the agent produces the list, which the user can then access independent from the browser. There is no bidirectional communication here as asserted by the Applicants. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined

Nehab, and Savitzky, and have monitored the second application--client, because Savitzky teaches providing agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This provides the benefit of providing an agent that is flexible, and does not depend or is tied down to either the client or server, and that can be quickly accessed by the browsers locally.

Claims 27-29, 31, 38, 42, 46, 48, 51, and 54-57, are directed to various methods, systems, etc., similar to claim 1, and therefore the response above likewise apply to them.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR


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system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for **all** Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
9/27/05